

REMARKS

With the entry of the present amendment claims 1-17, 19-23, 39- are pending in the application. Claims 18 and 53 have been canceled in the present amendment. Claims 24-38 were previously canceled. Claims 1, 19, 20, 22, 23, 39, 42-44 and 52 have been amended. Support for the amendments may be found throughout the application as filed including, but limited to, claims 1, 19, 20, 22, 23, 39, 42-44 and 52, as originally presented and paragraph 39 on page 11.

In view of the following remarks reconsideration and withdrawal of the rejections to the application in the Office Action is respectfully requested.

I. REJECTION OF CLAIMS FOR REASONS OF RECORD

In the Office Action the Examiner has rejected claims 1-23 and 39-43 for the same reasons offered in the previous Office Action, mailed January 24, 2005. Applicants maintain that the rejected claims, as previously presented, are in condition for allowance for the reasons provided in the response filed by Applicants on April 25, 2005. However, in order to expedite the prosecution of this application, Applicants have amended independent claims 1, 39, 44 and 52. These amendments should not prejudice Applicants' right to prosecute the claims in their previously presented form in a timely filed continuation application.

For the reasons set forth in Section II, which follows, Applicants believe the present amendments overcome the Examiner's rejections and respectfully request that these rejections be withdrawn.

II. REJECTION OF CLAIMS 44-53 UNDER 35 U.S.C. § 103(a)

The Examiner rejected claims 44-53 under U.S.C. § 103(a) as obvious over either U.S. Patent No. 5,061,354, issued to Smith et al. (hereinafter "Smith") or U.S. Patent No. 4,731,515, issued to Savage et al. (hereinafter "Savage") in view of U.S. Patent No. 4,416,751, issued to Berkowitz et al. (hereinafter "Berkowitz") and/or U.S. Patent No. 5,534,232, issued to Denes et

al. (hereinafter “Denes”) and further in view of U.S. Patent No. 5,660,465, issued to Mason (hereinafter “Mason”). Applicants respectfully traverse.

In order to establish a *prima facie* case of obviousness based on two or more references, the cited references, alone or in combination, must teach all limitations of the rejected claims. In addition, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. (MPEP 2142)

Relying on arguments from the previous Office Action, the Examiner rejected claims 44-52 based on the assertion that the provisions of pins on a rotating electrode would have been obvious. Applicants maintain that claims 44-52, as previously presented, were in condition for allowance for the reasons provided in the response filed by Applicants on April 25, 2005. However, in order to expedite the prosecution of this application, Applicants have amended independent claims 1, 39, 44 and 52 to include the limitation that the “first electrode” has at least one pin extending from its end piece, the at least one pin being mounted in a ceramic holder on the end piece.

The above-cited limitation was previously included in claim 53, which was newly added in Applicants previous response of April 25, 2005. In the present Office Action, the Examiner rejected claim 53 stating, “As to the provision of the recited ceramic holder in claim 53, it has been held that the motivation to make a specific structure is always related to the properties or uses one skilled in the art would expect the structure to have, *In re Newell* 13 USPQ 2d 1248, *Fromson v. Advance Offset Plate* 225 USPQ 26; *In re Gyurik* 201 USPQ 552.” Applicants respectfully submit that the case law relied upon by the Examiner in support of this rejection is not pertinent to the present prosecution, and further submit that, even if the case law were pertinent, it would fail to provide a *prima facie* case of obviousness.

Applicants respectfully note that the case law relied upon by the Examiner has been misconstrued by the Examiner and incorrectly asserted against the present claims. The holding,

“the motivation to make a specific structure ... is always related to the properties or uses one skilled in the art would expect the structure to have,” comes from *In re Newell*, 13 USPQ2d 1248, 1250 (CAFC 1989). In that case, all of the elements of the rejected claims had been identified in multiple prior art references and the issue before the court was whether the prior art provided motivation to combine the elements into a single invention. (See *In re Newell* at 1250.) The facts of the present prosecution differ from those of *In re Newell* because, in the present prosecution, the Examiner has failed to establish that all of the elements of the amended claims are known in the prior art. Specifically, the Examiner has failed to identify any prior art that teaches or suggests a ceramic pin holder. For this reason, Applicants respectfully submit that the case law relied upon by the Examiner in support of the rejection of claim 53 is inapposite and respectfully request that this rejection be withdrawn.

Applicants further submit that even if the Examiner had identified a reference showing that ceramic pin holders were known in the prior art, there would be no motivation to modify the electrode in the apparatus of Berkowitz or Denes to include the pins of Mason mounted in a ceramic pin holder because, contrary to the Examiner’s assertion, the properties and uses for the pins on the electrode would not suggest such a structure. This conclusion is supported by the Examiner’s own characterization of Mason in the previous Office Action, which stated:

“MASON shows in a device for mixing fluids the use of pins on an impeller for enhancing the mixing action (Fig. 2). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the references’ teachings as shown by Mason as this would result in further enhancing the mixing action.”

Thus, according to the Examiner’s own characterization of the prior art, the use for the structure allegedly suggested by the combination of Denes and Mason (i.e., a rotating electrode having pins extending from its surface) is to enhance the mixing action of a dense fluid medium. However, the Examiner has provided no basis for the conclusion that one of skill in the art would expect the pins of Mason to be mounted in a ceramic holder (*which is not taught or suggested in any of the cited references*), based on the use of the pins to enhance the mixing action of a dense

fluid medium. Therefore, because the Examiner has failed to identify any suggestion or motivation to modify the apparatus of the cited references to include a ceramic pin holder, as recited in each of the amended independent claims, Applicants respectfully request that this rejection be withdrawn.

In view of the foregoing remarks, applicants respectfully submit that all of the claims remaining in the application are in condition for allowance and favorable action thereon is respectfully solicited.

Respectfully submitted,

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